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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,283	04/22/2004	Tsutomu Ide	252187US2	7250

22850 7590 05/18/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
RESAN, STEVAN A	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/829,283	IDE ET AL.	
	Examiner	Art Unit	
	Stevan A. Resan	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 22 April 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6-2-2004.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katsumi et al JP 06-052541.

Katsumi et al disclose a magnetic recording medium having a non magnetic layer and a magnetic layer sequentially laminated on one surface

of a non-magnetic substrate wherein the magnetic layer contains a magnetic powder, a binder resin and an abrasive. The average height of protrusion of the abrasive from the surface of the magnetic layer measured by AFM is in the range of 15 nm or less which includes the range of 7.0 to 15.0 nm as in claim 1. [0007], [0026], Examples.

Nevertheless it would have been obvious to one of ordinary skill in the art to vary the surface properties of the media to optimize performance with a specific magnetic head-system.

The surface roughness of the magnetic layer may be in the range 0.1 nm – 6 nm which overlaps the range of claims 5-8.

The limitations of claims 2, 9-11 have not been given weight since they are directed to an intended use.

The limitations of claims 3 and 4 have not been given weight since these are process limitations. Process limitations cannot be given weight in article claims unless they can be shown to produce a patentably distinct article.

It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of

anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess the characteristic of a claimed product whether the rejection is based upon "inherency" under 35 USC 102 or on "prima facie obviousness" under 35 USC 103 jointly or alternately. In re Best 562 F2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159,441 F 2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F. 2d 531, 173 USPQ 685 (1972).

" When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". In re Spada. 911 F2d 705, 709, 15 USPQ 2d 1655 (Fed. Cir. 1990).

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Deno et al US 6120877 is cited for teaching the narrowing of the distribution of protrusion height of protrusions from the plane of a magnetic layer of a magnetic recording medium.

Murayama et al US 6773789 is cited for teaching a magnetic recording medium having a magnetic layer wherein the number of

protrusions having a height in the range of 10 nm to 20 nm projecting from the magnetic layer is limited.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (571) 272-1513. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

STEVAN A. RESAN
PRIMARY EXAMINER